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APPLICATION NO	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO	CONFIRMATION NO.
09/587,116	06/02/2000	Steven C. Quay	18072-000600US	6790

20350 7590 10/01/2002

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[REDACTED] EXAMINER

SMALL, ANDREA D SOUZA

[REDACTED] ART UNIT [REDACTED] PAPER NUMBER

1626

DATE MAILED: 10/01/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/587,116	<b>Applicant(s)</b> QUAY, STEVEN C
	<b>Examiner</b> Andrea D Small	<b>Art Unit</b> 1626
-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address -- <b>Period for Reply</b>		

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) Responsive to communication(s) filed on \_\_\_\_.  
 2a) This action is **FINAL**.      2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) Claim(s) 1-27 is/are pending in the application.  
 4a) Of the above claim(s) 13, 14 and parts of 1-12 and 15-27 is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_ is/are allowed.  
 6) Claim(s) 9-12, 17, 18, 21-24 and 26 is/are rejected.  
 7) Claim(s) 1-9, 15, 16, 19, 20, 25 and 27 is/are objected to.  
 8) Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on \_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 11) The proposed drawing correction filed on \_\_\_\_ is: a) approved b) disapproved by the Examiner.  
     If approved, corrected drawings are required in reply to this Office action.  
 12) The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All b) Some \* c) None of:  
     1. Certified copies of the priority documents have been received.  
     2. Certified copies of the priority documents have been received in Application No. \_\_\_\_.  
     3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
     \* See the attached detailed Office action for a list of the certified copies not received.  
 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
     a) The translation of the foreign language provisional application has been received.  
 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                    | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). ____   |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                           | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>3,9</u> . | 6) <input type="checkbox"/> Other: ____                                     |

## **DETAILED ACTION**

### ***I. Applicant's Response:***

Applicant's response dated 7/25/02 has been received and entered as paper no. 11.

### ***II. Restriction/Election:***

Applicants elected to prosecute without traverse group I, drawn to compounds wherein X is O, claims 1-12 and 15-27. Applicants further elected to prosecute the species of compound 4, in figure 1.

The generic concept is as follows:

Compound of claim 1, wherein:

X is O;

X1 is as claimed;

X2 is as claimed;

R2 is a member selected from reactive functional groups, alkyl groups terminally substituted with reactive functional groups and internally substituted with alkyl groups terminally substituted with a reactive functional group wherein the reactive functional group is selected from -OR3, -NHR4, -COR5, -SH, and CH2X3, wherein

-OR3 is a member selected from hydroxy, alkyl sulfonate and aryl sulfonate groups;

R4 is H;

R5 is a member selected from X3 and -OR6, wherein R6 is as claimed; and

X3 is halogen.

The claims that read on the instant generic concept are claims 1-12 and 15-27. The remaining subject matter of said claims and claims 13-14 are withdrawn from consideration as being drawn to non-elected inventions. 37 CFR 1.142(b).

***III. Rejections:***

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 9-12, 17-18, 21-24 and 26-27 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

These claims recite the limitation such as (CH<sub>2</sub>)<sub>n</sub>R<sub>7</sub>, SO<sub>2</sub>-R<sub>8</sub>, etc., that are not defined in claim 1. There is insufficient antecedent basis for this limitation in the claim, and these claims fail to further limit claim 1. Incorporating these claims into claim 1 is suggested to obviate the above rejections.

The term "inclusive" in the above cited claims is a relative term which renders the claim indefinite. The term "inclusive" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. Amending these claims to delete said term is suggested to obviate the above rejection.

***IV. Closest Prior Art:***

Schineller, et al is the closest prior art of record.

***V. Note to Applicant :***

Art Unit: 1626

Examiner requests an additional copy of 1449, IDS submitted on 11/14/2000, logged as paper no. 3.

***VI. Salutation:***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Andrea D. Small, whose telephone number is (703) 305-0811. The examiner can normally be reached on Monday-Thursday from 8:30 AM - 7:00 PM.

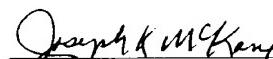
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Joseph K. McKane, can be reached at (703) 308-4537. The Unofficial fax phone number for this Group is (703) 308-7921. The Official fax phone numbers for this Group are (703) 308-4556 or 305-3592.

When filing a FAX in Technology Center 1600, please indicate in the Header (upper right) "Official" for papers that are to be entered into the file, and "Unofficial" for draft documents and other communications with the PTO that are not for entry into the file of the application. This will expedite processing of your papers.

Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [Joseph.McKane@uspto.gov]. All Internet e-mail communications will be made of record in the application file. PTO employees will not communicate with applicant via Internet e-mail where sensitive data will be exchanged or where there exists a possibility that sensitive data could be identified unless there is of record an express waiver of the confidentiality requirements under 35 U.S.C. 122 by the applicant. See the Interim Internet Usage Policy published by the Patent and Trademark Office Official Gazette on February 25, 1997 at 1195 OG 89.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist, whose telephone number is (703) 308-1234

Andrea D. Small  
September 26, 2002

  
\_\_\_\_\_  
Joseph K. McKane  
Supervisory Patent Examiner  
Art Unit 1626  
Technology Center 1